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EXAMINER

KAZIMI, HANI M

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/839,838

**Applicant(s)**

HARARA, MARWAN AHMED

**Examiner**

Hani Kazimi

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. This communication is in response to applicant's amendment filed on February, 7, 2005. The rejections cited are as stated below:

### *Response to Applicant's amendment*

2. Applicants' amendment filed on February 7, 2005 have been fully considered, and discussed in the next section below or within the following rejections are not deemed to be persuasive. Applicants' request for allowance is respectfully denied.

The amendment filed on February 7, 2005 is improper. The amendment should indicate that claims 22-44 are (currently amended) not (new).

### **§ 1.121 Manner of making amendments in applications.**

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1-5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the

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sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings.

### ***Specification***

3. The amendments filed on October 12, 2004 and February 7, 2005 are objected to under 35 U.S.C. 132(a) because they introduce new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows:

In the abstract;

".. a computerized.., .. digitally or electronically.. , .. using computerized, digital, electronic or any other similar or equivalent data input and output implementations,".

In the Field of the Invention of the disclosure which appears on Paragraph 0002 of page 1 of the application;

".. and identified, using computerized, digital, electronic or any other similar or equivalent data input and output implementations,".

In the Summary of the Invention of the disclosure which appears on last Paragraph of page 3 of the application;

".. ,using computerized, digital, electronic or any other similar or equivalent data input and output implementations,".

Furthermore, it's unclear the type of amendment that's being made to the first paragraph of page 3 of the application (Summary of the Invention), there are no underlines in the amendment indicating what's being added. Appropriate corrections are required.

### ***Specification***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in the claims. The specification, as originally filed does not provide support for the invention as now claimed.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

The applicant has amended claims 22-44 to include "computer-implemented" in the preamble and the claimed limitation "---are identified digitally or using similar or equivalent data-input and data-output implementations ---" in the body of the claim. However, the specification as filed does not provide an enabling disclosure to support the claimed features.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 22-44 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, claims 22-44 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. For further examination purposes, the Examiner interprets the claimed limitations in light of 35 U.S.C. § 112, first paragraph rejection.

***Claim Rejections - 35 USC 101***

8. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

9. Claims 22-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The newly added claimed limitations that are computer related are not supported by the original disclosure and considered to be new matter, e.g. adding "computer-implemented" in the preamble and the claimed limitation "---are identified digitally or using similar or equivalent data-input and data-output implementations ---" in the body of the claim. The specification as filed does not provide an enabling disclosure to support the claimed features. The examiner is not considering the newly added claimed limitations that are computer related.

Therefore, claims 22-24 remain rejected under 35 U.S.C. 101 because; the claimed invention is directed to a non-statutory subject matter. Specifically the method and medium claims do not claim a technological basis, e.g. structural / functional interrelationship that can only be computer implemented. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional interrelationship which

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can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential] and considered to be statutory.

### ***Claim Rejections – 35 USC 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 22-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Franklin et al. (U.S. Patent No. 5,883,810) as discussed in paragraph 5 of the previous office action.

12. Claims 22-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Zampese (U.S. Patent No. 6,014,650) as discussed in paragraph 6 of the previous office action.

### ***Response to Arguments***

13. In response to Applicant's arguments in the remarks:

A) Claims 22-24 remain rejected under 35 U.S.C. 101 because; the claimed invention is directed to a non-statutory subject matter (please see the above rejections).



B) Claims 22-24 remain rejected under 35 U.S.C. 102 as being anticipated by Franklin et al. (U.S. Patent No. 5,883,810) and Zampese (U.S. Patent No. 6,014,650).

The Examiner agrees with Applicant's statement that in order to anticipate a claim under 35 U.S.C. 102, a prior art reference must have an enabled disclosure for the subject matter **claimed**. MPEP § 2121. Applicant's claimed limitations are broader than intended. Both Franklin and Zampese disclose a computer-implemented method and a corresponding computer readable medium having a pre-designated monetary value attached to a tangible or intangible medium that can be identified through recognized means *unrelated to persons' personal information, including name, social security number or birth date* (at the time of transaction). It is noted that the features upon which applicant relies (i.e., the invention is based on anonymous transactions and no known and permanent account is needed. no known customer is needed are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant is arguing in substance that this invention is based on anonymous transactions and no known and permanent account is needed. no known customer is needed. However, these arguments are not claimed. What matters here and according to MPEP § 2121 is the subject matter **claimed**.

At the time of transaction neither Franklin nor Zampese disclose any personal information, including name, social security number nor birth date. The claim calls for a method of transaction comprised ....., this means when the transaction is conducted the

medium used in both references is unrelated to persons' personal information such as name, social security number, or birth date. The only way to find a user's personal information is to perform a search in a database and trace his/her identity. However, if a search is not performed then the transaction was performed anonymously and without disclosing any personal information and the medium used to conduct the transaction is unrelated to persons' personal information such as name, social security number, or birth date. Applicant is respectfully advised to view the arguments in light of the claimed subject matter.

### ***Conclusion***

**14.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP ' 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**  
Art Unit 3624

August 29, 2005